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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/774,354	01/30/2001	Paul J. Rank	30014200.1080/PJLM	2393

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EXAMINER

NGUYEN, MAIKHANH

ART UNIT PAPER NUMBER

2176

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/774,354

Applicant(s)

RANK ET AL.

Examiner

Maikhanh Nguyen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is responsive to communications: RCE filed 04/25/2005 to the original application filed 01/30/2001.
2. Claims 1-18 are currently pending in this application. Claims 1 and 10 have been amended. Claims 1 and 10 are independent claims.

Request Continuation for Examination

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/25/2005 has been entered.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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5. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As to claim 1:

The claim reads on a mental process or the manipulation of an abstract idea. The claim limitations are not explicitly directed toward steps being implemented on a computer, computer readable medium, or other statutory device. As such, they could be carried out mentally in conjunction with pen and paper. The claimed steps do not define a machine or computer implemented process (see MPEP 2106). Therefore, the claimed invention is directed to non-statutory subject matter.

As to claims 2-8:

The claims are rejected for fully incorporated the deficiencies of its respective base claim.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-4 and 10-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Horie et al.** (U.S. 6,487,597 – issued 08/1999) in view of **Schlaflly** (U.S. 5,471,612 – issued 11/1995, as cited by Applicant's IDS).

As to independent claim 1:

- a. Horie teaches:
- (i) obtaining said spreadsheet file in a first format on a first device (*selecting the range of a part of a character strings ...a screen of the personal computer; col.2, lines 7-9 & col.6, lines 6-8*);
 - (ii) converting the spreadsheet file to a second format; and transferring the spreadsheet file to a second device (*commanding transmission of the specified range of any part of data to the personal digital assistant ... creating a new file including the specified range of any part of data for transmitting the file via connecting means to the personal assistant; col.2, lines 37-52*).
- b. Horie, however, does not specifically teach “evaluating one or more formulas.”
- c. Schlaflly teaches evaluating one or more formulas (*Formula Evaluator ... compiling spreadsheet formulas; Abstract*).
- d. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Horie and Schlaflly because it would have provided increased the speed of transmission of the spreadsheet from the personal computer to the personal digital assistant.

As to dependent claim 2:

Horie teaches the first device is a computer (*a personal computer 10; col.4, lines 1-2 & Fig.1*).

As to dependent claim 3:

Horie teaches the second device is a small device (*PDA 13; col.4, line 5 and Fig.1*).

As to dependent claim 4:

Horie teaches the small device is a PDA (*PDA 13; col.4, line 5 and Fig.1*).

As to independent claim 10:

It directed to a computer program product for performing the method of claim 1, and is similarly rejected under the same rationale.

As to dependent claims 11-13:

They include the same limitations as in claims 2-4, and are similarly rejected under the same rationale.

8. Claims 5-9 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Wright et al.** in view of **Schlaflly** as applied to claims 1 and 10 above, and further in view of **Pajakowski et al** (U.S. 6,718,425 – field 05/2000).

As to dependent claim 5:

- a. The combination of Horie and Schlaflly does not specifically teach “the converting is performed by a conduit.”
- b. Pajakowski teaches the converting is performed by a conduit (*conduit software ... to convert; col.46, lines 55-64*).

- c. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine Pajakowski's teachings in the system of Horie as modified by Schlafly because it would have provided the enhanced capability for translating and moving data from one computer to another computer.

As to dependent claim 6:

- a. Horie does not specifically teach "gathering the one or more formulas."
- b. Schlafly teaches gathering the one or more formulas (*col.15, lines 1-30*).
- c. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Horie and Schlafly because it would have provided the capability for improving the speed with which electronic spreadsheets perform recalculation of spreadsheets.

As to dependent claim 7:

- a. Horie does not specifically teach "evaluating the formulas by the conduit."
- b. Schlafly teaches evaluating the formulas (*Formula Evaluator ... compiling spreadsheet formulas; Abstract*). Schlafly, however, does not specifically teach the use of conduit.
- c. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Horie and Schlafly because it would have increased the speed of transmission of the spreadsheet from the personal computer to the personal digital assistant.
- d. Refer to discussion of claim 5 above for rejection of "conduit".

As to dependent claim 8:

- a. Horie teaches compiling code that is readable by a small device (*col.7, lines 36-52*).

As to dependent claim 9:

- a. Horie does not specifically teach "parsing the formulas."
- b. Schlafly teaches parsing the formulas (*Abstract*).
- c. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of Horie and Schlafly because it would have increased the speed of transmission of the spreadsheet from the personal computer to the personal digital assistant.

As to dependent claims 14-18:

They include the same limitations as in claims 5-9, and are similarly rejected under the same rationale.

Response to Arguments

9. Applicant's arguments filed ^{4/25/2005} ~~08/28/2003~~ ^{USA} have been fully considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tuinenga

U.S. Patent No. 5,893,123

issued: Apr. 6, 1999

iambic, Inc., "Tinysheet -Excel spreadsheet software for Palm OS - Clie, Treo, Zire,

Tungsten & other PDAs", <http://www.google.com>, pp. 1-5, Copyright 1998.

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Hassinen, Kari et al., "Structured Spreadsheet Calculation", IEEE Languages for Automation Workshop, pp.129-133, 1998.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maikhanh Nguyen whose telephone number is (571) 272-4093. The examiner can normally be reached on Monday - Friday from 9:00am – 5:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MN


WILLIAM BASHORE
PRIMARY EXAMINER
6/10/2005